

REMARKS

Claims 1-3, 5-8, and 10-21 are pending in the application. Claims 13-16, 18, and 19 are withdrawn from consideration. Of the claims examined on the merits, only claim 1 is independent.

Claims 1-3, 5-8, 10, 11, and 20 stand rejected under 35 U.S.C. §102(b) as anticipated by Cragg.

The Examiner has kindly endeavored to point out where each element in Claim 1 is disclosed in Cragg. However, there are several inconsistencies in the rejection that make it fail. On September 1, 2006 an attorney for the Applicant spoke by telephone with the Examiner regarding the inconsistencies in the rejection.

The Examiner states in the rejection that the reference numeral 14 in Cragg is the claimed elongate swivel and that its first end is 22 and its second end is 24. During the telephonic interview, the Examiner indicated that the non-circular keyway on the first end is 38 which actually extends along the entire length of the swivel 14. The Examiner states in the rejection and confirmed during the interview that the first end of the swivel is capable of performing the functional language “for engaging a key on the engagement tool” because it has a reduced diameter portion 22. The Examiner also stated that the policy in her Art Unit is that if a prior art device is capable of performing the function

recited in the claim, it reads on the functional language whether or not the prior art device actually performs that function.

Claim 1 requires that there be a first length of string extending from the first end of the swivel and a second length of string extending from the middle of the swivel. In Cragg, a string extends from the middle and from the second end, not the first end. The Examiner stated during the interview that one could reverse the naming of the ends, i.e. call 24 the first end and 22 the second end. However, that results in the reduced diameter portion not being capable of performing the function of engaging the deployment tool because it is now on the wrong end. The Examiner agreed that this did appear to be a problem with the rejection but that she would not reconsider the rejection after Final and recommended filing an RCE or an Appeal.

The inconsistencies in the rejection of claim 1 as to which is the first end and which is the second end of the swivel also come into conflict with the last two clauses of claim 1. If 22 is the first end it will engage the end 30 of the tube 18 in Cragg, perhaps satisfying the functional language in clause "a)" of claim 1 but pulling on the string extending from the middle of the swivel (the claimed second length of string) will not cause the swivel to swivel off the deployment tool. If 24 is considered the first end, it will be incapable of engaging the deployment tool.

Claims 2, 3, 5-8, 11 and 20 depend either directly or indirectly from claim 1 and therefore, the argument made above regarding claim 1 applies to these claims as well.

Further, with regard to claim 3, if 30 in Cragg was considered the “non-circular keyway” it cannot also be the surface groove of claim 3. As to the reduced diameter portion of claim 5, the first end, second end conundrum comes into play again.

In addition with regard to claim 11, there is no mention of a pushrod in Cragg. The Examiner states that the disposable liner 70 in Cragg reads on the hollow pushrod. However, as seen in Fig. 7 of Cragg, the distal end of the liner 70 does not face the first end of the swivel.

Claims 1, 2, 6-8, 10, 11, 17 and 20 stand rejected under 35 U.S.C. §102(b) as anticipated by Cerier et al. Cerier et al. discloses a suture anchor and driver assembly. The Examiner states that the anchor 92 in Cerier reads on the swivel claimed in claim 1. However it is not a swivel as that term is defined in the instant specification and in claim 1. In addition, the strings in Cerier are not arranged as claimed in claim 1. In the embodiment of Fig. 8 which the Examiner has chosen to read on claim 1, both lengths of string 18 extend from the first end of the anchor 92. In the embodiment of Fig. 2 both lengths of string extend from the sides of the anchor 16.

In Fig. 8 of Cerier et al. the string 18 exits one side hole 90 and enters back into the opposite side hole 90. Thus, one could argue that the second length of string of claim 1 is the length of string between the two holes 90 on the outside of the anchor 92. However, that interpretation would contradict other parts of claim 1. The string would not be long enough such that it may be pulled from outside the body cavity and pulling on it

would not cause the anchor to swivel off anything. Nevertheless, a minor amendment to claim 1 has been made to make it impossible to misconstrue. And impossible to read Cerier et al. thereon.

Claims 2, 6-8, 10, 11, 17 and 20 depend either directly or indirectly from claim 1 and therefore, the argument made above regarding claim 1 applies to these claims as well. In addition, if the Examiner interprets the anchor 92 as being substantially cylindrical to reject claim 2, then it cannot be considered to have a reduced diameter portion to reject claim 5 which depends from claim 2. To do so would require interpreting the three ridges 62 as a cylinder which they clearly are not, under any definition and certainly not as that term is used in the instant specification.

With regard to claims 11 and 17, there is no pushrod extending through a hollow tube in Cerier. The Examiner states that 12 is the hollow tube and 22 is the pushrod. The device 10 is described by Cerier as having a shaft 12 with an end projection 22. The shaft 12 is shown and described as being a solid stainless steel rod. The projection 22 clearly does not extend through the shaft 12. It extends away from it.

Claims 1-3, 6-8, 10, 11, and 20 stand rejected under 35 U.S.C. §103(a) as obvious over Cope. The Examiner refers to anchor 30 in Cope and calls out the first end 32 and second end 34. Although the Examiner refers to Figs. 1 and 4-6, Fig. 7 of Cope seems more relevant. In any case, although the Examiner states that the anchor 30 has a keyway she does not identify it and the Applicant does not see it in the Figures of Cope. Moreover, the words key and keyway do not appear in the Cope reference. It is thus

respectfully submitted that the only way any portion of the anchor 30 could be interpreted as a keyway would be if one were looking for a keyway. Why would one be looking for a keyway? Only to reject claim 1. This is the clearest example of impermissible hindsight.

The Examiner states that Cope discloses all except a non-circular keyway and that the Applicant has not disclosed that such a keyway solves any particular problem. As stated above, it is the Applicant's position that Cope does not disclose any kind of keyway, never uses the words key or keyway. The Examiner is apparently applying the so-called "obvious matter of design choice" and cites a case as required by this type of rejection.

The Examiner's "obvious matter of design choice" rejection is flawed for two reasons: first, hindsight is necessary to find a keyway in Cope, and second, the Applicant has described the functions of the key 18 and keyway 24e and it is apparent that not any key-keyway combination would perform the function of the key and keyway described by the applicant. See, e.g. page 11, lines 7-19 of the Applicant's specification.

The Examiner has made the Applicant's task of responding to this rejection difficult by not identifying what she is interpreting as the key and keyway in Cope. The Applicant can only assume that the Examiner is referring to the engagement of the reinforcing member 20 in the annular space between the proximal end 32 of the anchor 30 and the attachment member 50 as shown in Fig. 10 of Cope. If one were inclined to think of keys and keyways, one might consider this arrangement to be a circular key and

keyway. However, it is worth repeating that the only way one would be inclined to think of keys and keyways in this instance would be to first read the Applicant's patent application. The Examiner surely knows that that is the essence of hindsight.

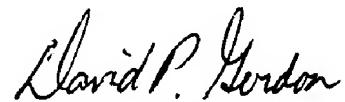
Now as to why a non-circular key and keyway are necessary, the Examiner should refer to the above cited portion of the Applicant's specification and compare that with the descriptions of Figs. 13 and 14 of Cope. In the case of the Applicant's swivel, it is deployed as illustrated in Fig. 6 of the application. There it can be seen that the non-circular key and keyway allow the swivel to disengage the pushrod 18 when the second length of string is pulled up. i.e. away from the patient and toward the practitioner. Compare this with Figs. 10-13 of Cope. One doesn't need a degree in mechanical engineering to see that pulling suture 40 to the right in Fig. 10 or to the left in Fig. 12 will not disengage the anchor 30 (35) from the reinforcing member 20. The imagined circular key and keyway engagement will prevent that from happening. Cope must move his reinforcing member away from the patient as shown in Fig. 13 in order to disengage the anchor 35. The Applicant's use of a non-circular key and keyway allow the swivel to be deployed by moving the pushrod 18 towards the patient. This also allows the use of the push-button 22 which is more precise than the freely sliding member 20 in Cope. Further, the non-circular key and keyway in the Applicant's retractor device allow the swivel to be much more securely attached to the deployment device prior to deployment. Compare Figs. 2 and 6 of the Applicant's application. It is respectfully submitted that these differences are sufficient to overcome a "design choice" rejection even if such a

rejection were properly made. As stated twice above, this rejection is clearly based on hindsight because Cope never mentions keys or keyways.

Claim 21 stands rejected under 35 U.S.C. §103(a) as obvious over Cope or Cragg or Cerier in view of Pedlick. Since claim 21 depends from claim 20 which depends from claim 1, the arguments made above regarding the applicability of Cope, Cragg, and Cerier apply to this rejection as well. In addition, the wedge shaped suture anchor of Pedlick does not have two different colored lengths of string attached to it as claimed in claim 21. Pedlick teaches a suture anchor coupled to a colored suture so that the suture can be distinguished from sutures coupled to other anchors.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,



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